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FAY, SHARPE, FAGAN, MINNICH & MCKEE, LLP

PATENT TRADEMARK AND COPYRIGHT LAW

1100 SUPERIOR AVENUE

SEVENTH FLOOR

CLEVELAND, OHIO 44114-2579

TELEPHONE (216) 861-5582

FAX (216) 241-1666 AND (216) 241-5147

DATE: February 20 2004

TO: U.S. Patent and Trademark Office

ATTN.: Examiner J. J. Rhee, Art Unit 1772

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FROM: Thomas E. Young, Esq.

RE: Serial No. 09/711,478
Filed : November 13, 2000
Our Ref.: MAEE 2 12957

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COMMENTS

Attachment: Request for Reconsideration

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTOR(S) : Brian A. Vulpitta, et al.
TITLE : ANTI-TELESCOPING ADHESIVE
TAPE PRODUCT
APPLICATION NO. : 09/711,478
FILED : November 13, 2000
CONFIRMATION NO. : 7902
EXAMINER : J. J. Rhee
ART UNIT : 1772
LAST OFFICE ACTION : January 16, 2004
ATTORNEY DOCKET NO. : MAEE 2 12957
Cleveland, OH 44114
February 20, 2004

REQUEST FOR RECONSIDERATION

MAIL STOP AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Office Action of January 16, 2004 has been received and carefully studied. Applicants request reconsideration of the rejections set forth in that Office Action.

As the Examiner is aware, the present application is concerned with adhesive tape products, specifically the kinds of products seen in households and in stationery applications. Such products generally consist of a long narrow strip having an adhesive on one side. This adhesive tape is wound up on a core and sold to consumers. The problem applicants are addressing is the problem of telescoping. In a telescoped roll of adhesive tape, each succeeding layer in the roll is slightly offset from the underlying layer. The roll of tape is no longer disk shaped. Rather, it is conical or cup shaped. Such a product is perceived by consumers as defective.

Claims 1-10 are pending in the application.

In paragraph 3 of the Office Action, claims 1-5, 5-11 are rejected as unpatentable over

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Schonhorn, et al. (0430548). Claim 1 recites a hollow cylindrical core and a length of adhesive tape wound upon that core. The length of tape must comprise a leader portion fixed to the core, a foam support portion and a usable tape portion. The claim also requires a compressible foam strip fixed to the tape foam support portion. Schonhorn does not teach these structures. Rather, Schonhorn teaches modifying the core. In Schonhorn's first embodiment, the core is slit axially.

This provides a gap extending from one edge to the other. In this way, the core is compressible. The body of tape is then wound upon this compressible core. In the second embodiment, the one relied upon in the Office Action, the collapsible core is achieved by enveloping the outer surface of the core with foam. The foam is glued to the core. The foam is on the order of 1-3mms thick.

Applicants' structure is different. Applicants do not make the core compressible. Rather, applicants add a layer of compressible foam to the tape which is then wound around the core. This uses the adhesive already on the tape to bind the foam in place. Applicants do not need to separately adhere the foam to the core. Thus, claim 1 requires a length of tape to form a leader which is attached to the core. Claim 1 also requires a foam support portion to which foam is attached which is then wound around the core. The claim then requires that the tape continue to a usable tape portion wound around the core and foam completing the product.

The Office Action acknowledges that Schonhorn fails to disclose a tape divided into a leader portion, a foam support portion and a usable tape portion. The Office Action asserts that Schonhorn teaches that the adhesive on the core serves the equivalent function as the leader portion and the foam support portion. Applicants respectfully disagree. The passage in Schonhorn pointed to in the Office Action (column 5, lines 4-6) merely recites that the foam body may be secured to the core by means of adhesive. This teaches nothing concerning the use of a tape to secure the tape and a foam strip in place wound upon the core. In applicants' invention, the foam strip is not adhered to the core. Rather, it is adhered to the portion of tape which it contacts. Thus, the Schonhorn passage points away from applicants' structure, not toward it.

The Office Action next points to the passage in Schonhorn starting at column 4, line 56 and finishing in column 5, line 1. That passage merely endorses the enveloping of the outer surface of a non-severed core with foam. It does not describe the advantages or the structure of applying an adhesive tape leader to the tape core, attaching a foam strip to a length of the adhesive tape and then wrapping the entire adhesive tape body around the core. Nothing in the reference suggests this structure or that this structure would be equivalent to adhering the foam directly to the core. It must be remembered that in the structure disclosed and claimed in claim 1, the adhesive strip is not adhesively bound to the core but is adhesively bound to the tape.

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The section of the Office Action asserting that Schonhorn teaches the equivalent structure to claim 1, closes with the assertion that Schonhorn teaches the equivalent function of Applicants' anti-telescoping adhesive product. Applicants' respectfully disagree as the specific passages recited do not support the conclusion made. Schonhorn and the prior art do not show such equivalence.

It appears that the Office Action is based upon a reading of Applicants' specification and use of these teachings to say that these structures are equivalent. Such a basis of rejection is improper under *In re Ruff*, 256 F.2d 590, 596, 118 USPQ 340, 346 (CCPA 1958). One may not use the teachings of an application to establish equivalency of structures in a particular application. The equivalency of structures in addressing a particular problem must come from the prior art, not the application being examined.

It is respectfully submitted that claim 1 and claims 2-6 depending from claim 1 are allowable over Schonhorn for the reasons stated above. Additionally, claims 6-10 all require a bulge in the outer surface of the tape core making it barrel shaped. Schonhorn does not teach such a structure. It is submitted that claims 6-10 are also allowable over Schonhorn.

The Office Action also continues the rejection of claims 6-10 as unpatentable over Schonhorn in view of Martin-Cocher, et al. In applicants' amendment filed on May 14, 2003, this rejection was addressed in a number of ways. First, it was asserted and supported with resort to factual analysis and case law that Martin-Cocher is not analogous art. Second, it was asserted and supported by factual analysis that there is no teaching in the prior art to combine Schonhorn and Martin-Cocher. In the latest Office Action, these points are responded to be citation to *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992) and an assertion that the field of applicants' endeavor is the wrapping of material around a core. It is respectfully submitted that this is not the field of applicants' endeavor. Nor is it describing the problem applicants are addressing. The concept of finding a common broad thread in the references and calling it the field of applicants endeavor is not supported by *In re Oetiker*. Rather, the opposite is supported.

In *In re Oetiker* applicant described and claimed a hose clamp. The applicant used a hook to maintain the preassembled condition of the hose clamp and the hook automatically disengaged when the clamp was tightened. Claims were rejected based upon an earlier Oetiker patent on a hose clamp and Lauro '400 describing a plastic hook and eye fastener used in garments. Oetiker argued that there was no suggestion or motivation to combine the two references and also argued that Lauro was not analogous art. The Examiner and the Board of Appeals disagreed. The Court of Appeals characterized the PTO position as follows:

The Examiner stated that "since garments commonly use hooks for securement", a person faced with a problem of unreliable maintenance of a pre-

assembly configuration of an assembly line metal hose clamp would look to the garment industry art. The Examiner explained further by stating that "appellant's device as disclosed could be utilized as part of a garment". The Board did not repeat or support the Examiner's argument, or discuss its relevance. Indeed the argument is not supportable. However, the Board held that the Lauro reference, although not "within the appellant's specific field of endeavor" is nonetheless "analogous art" because it relates to a hooking problem, as does Oetiker's invention. (at 1445)

The Court of Appeals stated:

It has not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments. The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. (at 1446)

The Court of Appeals reversed the rejection and allowed the claims.

The Oetiker case is directly applicable here. Applicants' field of invention is consumer and stationery adhesive tape products. The problem the application is addressing is telescoping of such products. One can not, under the Oetiker holding, simply broaden out the field of the invention to include all things that are connected with a hook (as in Oetiker) or all things that are wrapped upon something (as here) to justify a rejection. For the reasons described in the Oetiker case, it is submitted that Martin-Cocher is not analogous art. It is not a proper reference. Rejections base upon Martin-Cocher are improper and should be withdrawn. Moreover, the references do not teach the combination proposed.

The Office Action asserts with respect to the second point raised above that it is appropriate to combine the two references since Martin-Cocher teaches the general concept of a material wrapped around a core as do applicants. This does not establish a teaching in the prior art that will lead one to combine these two references to address the problem being addressed by applicants. Again, the Oetiker case speaks to this situation. "There must be some reason, suggestion or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself."

There is no suggestion in either Martin-Cocher or in Schonhorn which would lead one to the other reference. Schonhorn does not even consider changing the profile of a tape core to a barrel shape. Martin-Cocher doesn't teach anything concerning tape cores. It is respectfully submitted that nothing has been pointed to which would lead one to combine these two references as suggested. For the reasons stated above and for the reasons stated in the

amendment of May 14, 2003, claims 6-10 are allowable. Specifically, nothing in either reference or in the two references combined (which is improper), teach an adhesive tape product using a core which bulges at its center line to address the telescoping problem. Thus, claim 6-10 are allowable. Moreover, nothing in either of references teach the use of this barrel shaped core in combination with a layer of foam. Thus, claims 6 and 8-10 are allowable.

It is respectfully requested that the Examiner reconsider and withdraw the rejection.

Respectfully submitted,

FAY, SHARPE, FAGAN,
MINNICH & MCKEE, LLP

February 20, 2004
Date

Thomas E. Young
Thomas E. Young
Reg. No. 28,924
1100 Superior Avenue
7th Floor
Cleveland, Ohio 44114-2579
(216) 861-5582

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Signature

Elaine M. Checovich

Printed Name

Elaine M. Checovich